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In re Application of
LIANG, Hong, et al.
Application No.: 10/070,560
PCT No.: PCT/US00/25166
Int. Filing Date: 14 September 2000
Priority Date: 14 September 1999
Attorney Docket No.: 05213-0551US
For: METHOD OF PRODUCING AND
PURIFYING ENDOSTATIN™
PROTEIN

DECISION ON

PETITION UNDER

37 CFR 1.47(a)

This is a decision on applicants' "Petition Under 37 C.F.R. §1.47(a) For an Uncooperative Inventor," filed in the United States Patent and Trademark Office (USPTO) on 17 September 2002.

BACKGROUND

On 14 September 2000, applicants filed international application PCT/US00/25166. A Demand for international preliminary examination, in which the United States was elected, was filed on 16 April 2001, within nineteen months from the priority date. Accordingly, the thirty-month period for paying the basic national fee in the United States expired at midnight on 14 March 2002.

On 08 March 2002, applicants filed a submission for entry into the national stage in the United States which was accompanied by, *inter alia*, the U.S. Basic National Fee.

On 12 June 2002, the Office mailed a Notification of Missing Requirements (Form PCT/DO/EO/905) indicating, *inter alia*, that an oath or declaration of the inventors in compliance with 37 CFR 1.497(a)-(b) was required.

On 17 September 2002, applicants submitted the instant petition under 37 CFR 1.47(a).

DISCUSSION

A petition under 37 CFR 1.47 must be accompanied by: (1) the fee under 37 CFR 1.17(h), (2) proof of pertinent facts, namely that the inventor refuses to sign after being presented with the application papers or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, and (4) an oath or declaration by the 37 CFR 1.47(a) applicant on behalf of himself or herself and the nonsigning applicant

Items (1) and (3) have not been met. (1) The petition fee has been paid. (3) The petition lists the last known address of non-signing inventor Lourdes Bermejo as 112 Durston Loop, Morrisville, NC 27560.

Item (2) has not been satisfied. Applicants claim that Ms. Bermejo has refused to sign the declaration. However, applicants have neither established that they have located Ms. Bermejo, nor that they presented her with a complete copy of the application papers. MPEP 409.03(d). The letter addressed to Ms. Bermejo does not indicate that a complete copy of the application was enclosed and the Fedex package was returned with Ms. Bermejo listed as "not in".

Further, the statement of facts should detail the efforts to locate Ms. Bermejo and her refusal. Instead it indicates that Ms. Bermejo's former employer was repeatedly asked to locate her. "The statement must be signed where at all possible by a person having firsthand knowledge of the facts recited therein." MPEP §409.03(d).

Item (4) has not been satisfied. Inventor Zhou is listed as "Xinhau Zhou" on the international application, but as "Xinhua Zhou" on the declaration executed by Inventor Zhou. Inventor Shepard is listed as Scott R. Shepard on the international application, but as "Scot R. Shepard" on the declaration. If these are typographical or transliteration errors, they can be corrected by a statement from the applicant. See MPEP 201.03.

CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(a) is **DISMISSED** without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Failure to timely file the proper response will result in abandonment of this application. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." No additional petition fee is required.

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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